

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/028,400	Applicant(s) ZANINI ET AL.	
	Examiner Frank I. Choi	Art Unit 1616	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Since the Amendment (3/9/2006) has not been entered, the claims are rejected for the reasons set forth in the prior Office Action (2/9/2005). Further, please consider Appendix A.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☒ Other: See PTO-892 attached hereto.

APPENDIX A

Although the Amendment (3/9/2006) has not been entered, for purposes of furthering prosecution please consider the following when preparing any subsequent response:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

If the Amendment (3/9/2006) had been entered, Claims 1,5-11 14-17, 19, 21-24, 73-75 would be rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Rathore et al. (US 2004/0151755) expressly disclose silicon soft contact lenses prepared by adding 0.20 weight percent of CYST to a monomer mix of Table I, curing in a molds and placing in 0.315 mg/ml solution of silver nitrate with the $[Ag]_{NR}$ calculated to be 57(2) ppm based on the release rates (Paragraphs 0068-0083,0099-0100). The inventive entity in the present application is not the same as that in Rathore et al.. WO 2004/047878 expressly disclose silicon soft contact lenses prepared by adding 0.20 weight percent of CYST to a monomer mix of Table I, curing in a molds and placing in 0.315 mg/ml solution of silver nitrate with the $[Ag]_{NR}$ calculated to be 57(2) ppm based on the release rates (Page 17, lines 20-35, Pg. 18, lines 1-20, Pg. 25,lines 14-26, Pg. 26, lines 1-10). The inventive entity in the present application is not the same as that in WO 2004/047878. Enns et al. (US 2004/0213827) expressly disclose silicon soft contact lenses prepared by adding 12000 ppm of CYST to a monomer mix of Table I, curing in a molds and placing in approx. 0.7 mcg/ml of silver where the contact lenses exhibited silver content of 70, 75 and 100 ppm (Paragraphs 0161-0173). Further, Enns et al.

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expressly discloses a lens formulation in which etafilicon A or aquafilicon A contains CYST (0.01 weight percent) and silver (30 ppm) (Claims 22, 23). Finally, Enns et al. expressly discloses a lens formulation which contains polymer containing the claimed monomer of claims 74 and 75 and silver (Claim 15). Meyers et al. (US 2004/0115242) expressly disclose silicon soft contact lenses prepared by adding 12000 ppm of CYST to a monomer mix of Table I, curing in a molds and placing in approx. 0.7 mcg/ml of silver where the contact lenses exhibited silver content of 70, 75 and 100 ppm (Paragraphs 0297-0310). Further, Meyers et al. expressly discloses a lens formulation in which etafilicon A or aquafilicon A contains CYST (0.01 weight percent) and silver (30 ppm) (Claims 22, 23). Finally, Meyers et al. expressly discloses a lens formulation which contains polymer containing the claimed monomer of claims 74 and 75 and silver (Claim 15). The inventive entity in the present application is not the same as that in Meyers et al..

Conclusion

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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April 25, 2006


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